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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,339	05/25/2001	Kerry S. Atkinson	568	2329

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EXAMINER

MILLER, EDWARD A

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/864,339

Applicant(s)

ATKINSON ET AL.

Examiner

Edward A. Miller

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see next page.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

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1. The period for reply continues to run THREE MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 or a request for a continued examination (RCE) in compliance with 37 CFR 1.114 must be timely filed to avoid abandonment of this application.

2. In the request for reconsideration, page 2, applicants referred to the reference “newly cited by appellants...” It is correct that the reference was filed October 21, 2003; however, this date was subsequent to the date of the final rejection of June 26, 2003. Thus, under current rules, this reference could not be used in an Examiner’s Answer, as it would be new to the record, that is, not used in the final rejection. Further, reference has been made to the “specific notoriously well known ingredients” from the first action on the merits dated December 20, 2002. Due to changes in rules and challenges to what is well known in the art subsequent to the final rejection, a new final rejection was made, to essentially the same effect as the original rejection, but with support for what is notoriously well known in the art.

3. As to applicants’ arguments, applicant urges that the examiner has ignored the requirement that the added water forms “a second discontinuous phase.” Contrary to applicants’ allegations, one of ordinary skill in the art would have known that the practical result of later injecting an energy reducing substance comprising water into an pre-formed, strong explosive emulsion, would be to weaken it. Indeed, see the final rejection mailed April 23, 2004, one finds “Patterson et al. ... further shows the aspect of adding a water phase separately to an already formed emulsion.” This is followed by another sentence with specific places in the reference teaching that specific issue. Such

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is not ignoring applicants' arguments as argued, this is proving via Patterson et al., in the prior art and cited by applicants, that applicants' allegations lack basis in fact.

4. In view of applicants' arguments on page 3 of the arguments, it may be that applicants are making a point that Patterson et al. is adding an emulsion, which applicants "distinguish" by reciting water or solution, and by the order of addition (steps). For the second point, note MPEP 2144.04:

C. Changes in Sequence of Adding Ingredients

Ex parte Rubin, 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render prima facie obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). See also *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results); *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is prima facie obvious.).

For the first point, note that independent claim 10, has a scope of "comprising." No claim limits this scope. In Patterson et al., a preferred second emulsion is only water and oil, col. 3, lines 18-28. Looking at specifically referred to col. 3, lines 45-50, adding the second emulsion as taught in Patterson et al. results in a two phase w/o emulsion. This is further explained in lines 51 through 65, immediately following, wherein a single oil phase, with two discontinuous phases results, the first discontinuous phase being micelles of ammonium nitrate phase, and the second, micelles of water. This is what applicants incorrectly urge is not taught. Further, the caution that if too much energy is used in mixing the separate discontinuous phases will coalesce, and that the separate phases remain stable, lines 56-58, is taught. The final result is emphasized in lines 63-65. Due to the "comprising" scope claims, the energy reducing agent comprises a water containing emulsion; water is added

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thereby, within the scope and content of the claims. In Example 5, col. 5, lines 59-62, the final explosive may be altered or tailored by changing the amount of water in the final composition.

This is also a variation of the order of steps issue. The final result is the same as far as taught or shown in the record. That is, the strength is reduced by the product having extra water in it, compared to a full strength emulsion explosive. However, variation of the strength of an emulsion explosive is well known and shown by the cited prior art. Further, variation of amounts and ingredients, that is, result effective variables, is also obvious, note the case law cited from the first action on the merits. Further, applicants' final result in micro structure is the same, two separate dispersed phases, in a single oil phase, just as taught. Thus, it is particularly obvious to vary the order of addition of ingredients, i.e., water in two portions rather than only one. The claim language of adding water is construed to include the addition of water or water solution as a dispersed phase within an emulsion which also includes oil. The overall claim scope of "comprising" admits of this, even if applicants' arguments differ on this point.

5. Next, consider the big picture. This invention really is watering down the emulsion explosive. Applicants could not have reasonably misunderstood the examiner's contention as to "watering down," as set forth in the first instance of the claims reciting addition of water or aqueous solution, in the rejection dated June 26, 2003. This method is diluting the strength of the product, by the addition of water. Regardless of any practical advantages in use, the essence of this method is "watering down" the explosive to reduce or dilute its strength, just as understood from the term as understood. This examiner feels, that this invention should not be on offer for the internet page found when one searches for "funny patents", as with sideways swinging and the "stick" patent. Compare *In re Goodman*, 339 F.2d 228, 232, 144 USPQ 30, 33, "The failure of the prior art to

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mention a problem" [here, the need to dilute an emulsion] "may be due to the fact that in practice the problem is not a serious one or that a large number of satisfactory solutions is readily apparent."

6. As to the declaration, declarant appears to misunderstand the prior art and the broad claim construction, as detailed above by the examiner. It was believed that the previous rejection was well set forth and understood by one registered to practice before the Office, although patent law concepts are less understood by those not versed in patent law. Applicants' arguments in their reply, have been answered to clarify that they were in fact previously addressed in the final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward A. Miller whose telephone number is (703) 306-4163. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Miller/em
August 16, 2004



EDWARD A. MILLER
PRIMARY EXAMINER